

Mika PARTAIN et al., S.N. 09/760,864
Page 11

Dkt. 2271/5325

REMARKS

The application has been reviewed in light of the ~~final~~ Office Action dated October 25, 2004. Claims 1-21 are ~~pending~~, with claims 1, 6, 15, 20 and 21 being in independent form.

Claims 1-21 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,078,897 to Rubin et al.

Sales of products through the Internet can be enhanced by offering promotions functionally related to an order the customer places, in order to induce the customer to increase the order or place an additional order. The techniques described in this application provides for display of promotion information (a) only if the initial order meets or exceeds a minimum quantity, and (b) no promotion information is displayed if the initial order does not meet or exceed the minimum quantity.

Rubin does not teach or suggest such features. According to Rubin, when a proposed order is received from a customer, one or more additional orders is identified that, when added to the proposed order increases the discount for the total order to a level that is higher than the volume discount of the proposed order, regardless of whether the proposed order is above a minimal quantity.

The Office Action states that Fig. 3 of Rubin discloses displaying at the customer side information indicative of a promotion functionally related to the initial, only if the specified quantity of the specified product is higher than the

BEST AVAILABLE COPY

Mika PARTAIN et al., S.N. 09/760,864
Page 12

Dkt. 2271/636

minimum quantity, wherein no promotion is displayed at the customer side if the specified quantity does not meet or ~~exceed~~ the minimum quantity, as provided by the claimed invention. However, the Office Action states that Rubin discloses ~~such~~ features of the claimed invention because the "only if ..." and "if ..." clauses have no patentable weight since they ~~are~~ conditional limitations.

In essence, the Examiner has disposed of pertinent differences between the claimed invention and Rubin [that is, features (a) and (b)] by disregarding the differences.

Applicants respectfully submit that features (a) and (b) are patentable distinctions of the claimed invention over Rubin, and it is an error to disregard such material distinctions of the claimed invention over the cited art.

The relevant case law is clear. Anticipation under 35 U.S.C. §102 requires that each and every limitation of the claimed invention must be disclosed expressly or inherently by a single cited reference. It is error to disregard a claim limitation as being irrelevant [see Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F.2d 955, 961-962, 1 U.S.P.Q.2d 1196 (Fed. Cir. 1986); In re Soli, 317 F.2d 941 137 U.S.P.Q. 797, 801 (C.C.P.A. 1963)]. There is simply no legal precedence supporting the Examiner's contention that conditional limitations can be ignored.

Feature (a) of the claimed invention provides for display of promotion information only if the initial order meets or exceeds

Mika PARTAIN et al., S.N. 09/750,864
Page 13

Dkt. 2271/53926

a minimum quantity. That is, no promotion information is displayed if the initial order does not meet or exceed the minimum quantity (Feature (b) of the claimed invention]. The "only if ..." and "if ..." clauses specify when promotion information is displayed and not displayed, respectively. Each of the independent claims (1, 6, 15, 20 and 21) includes such features.

Figure 3 of Rubin clearly does not disclose features (a) and (b). Step 324 in Figure 3 of Rubin provides for display of promotion information regardless of the quantity of the initial order. No comparison to a minimum order is made to determine whether the promotion information is to be displayed. The promotion information is always displayed, once an initial order is received.

Applicants maintain that the claimed invention is patentable over Rubin because Rubin does not expressly or inherently disclose or suggest features (a) and (b) of the claimed invention.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition. The Office is hereby authorized to charge any fees that may be required in connection with this response and to credit any overpayment to our Deposit Account No. 03-3125.


If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Mika PARTAIN et al., S.N. 09/760,864
Page 14

Dkt. 2271/63926

Allowance of this application is respectfully requested.

Respectfully submitted,


Paul Teng, Reg. No. 40,837
Attorney for Applicants
Cooper & Dunham LLP
Tel.: (212) 278-0400